

Appl. No. 10/822,372
Amdt. dated October 10, 2006
Reply to Office action of July 10, 2006

Remarks/Arguments

Claims 7 and 9 -20, withdrawn from consideration in this application, have been cancelled and will be pursued in separate divisional applications. New claims 21 - 30 have been added.

Claims 1 and 3-6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman alone or in combination with secondary references. Reconsideration and withdrawal of the rejection is requested in view of the above amendments and for the following reasons.

The newly cited Coleman patent discloses a hollow block to be used in wall construction. As the Examiner correctly notes, the block does include conduits that are joined by spacers. However, the block has a closed top, with access only being possible through the upper ends of the conduits. If it is desired to fill the block interior with insulation, the insulation is introduced through the upper ends of the conduits (apertures). The insulation can then migrate through slits in the cylinders to the interior of the block.

The Coleman structure would be unsuitable for applicant's purpose, i.e., the formation of a concrete pad with a plurality of vertical conduits extending from the top to the bottom of the pad so that water on top of the pad can flow through the conduits to the bottom of the pad, where it can migrate into the soil beneath the pad. In this application, applicant is claiming a form that is suitable for use in the manufacture of these concrete

pads.

As now specifically claimed, applicant's form is an open-top form with conduits that have removable caps. Support for the term "open-top" is found in the drawings, specifically Figs. 1 and 7. Thus, no new matter is introduced. Therefore, as now defined, applicant's structure is distinguishable from the closed-top structure shown in Coleman. Moreover, there is no suggestion in Coleman or any secondary reference that would lead or suggest to one skilled in the art modification of the Coleman structure in this manner. In fact, modification of Coleman to an open-top structure would defeat the purpose of the Coleman invention.

The whereby clause of all of the amended claims further distinguishes the invention. While a whereby clause is not given weight when it simply expresses the intended result, the Federal Circuit has held that a "whereby" clause cannot be ignored where the clause states a condition that is material to patentability. See *Hoffer v. Microsoft Corp.* 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005). MPEP 2111.04. Here, the whereby clause does define a condition that is material to patentability, namely the ability to pour concrete into the form around the conduits.

Newly added claim 30 defines a form having additional distinctions over Coleman and the secondary references. Specifically, claim 30 defines a form that is a vacuum formed, open-top form produced from a single sheet of thermoplastic polymer which includes a plurality of spaced, vertically aligned conduits, spacers connecting the conduits, and a horizontal floor extending upwardly to form the conduits and spacers.

Accordingly, for the forgoing reasons, and in view of the amendments to the claims, it is believed that this application now defines a patentably distinguishable invention and is in condition for allowance. Such action is respectfully solicited.

Respectfully submitted,



William J. Mason
Registration No. 22,948

Date: October 10, 2006
File No. 5724-001